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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,540	04/18/2001	Naoto Kinjo	Q63865	6811
7590 01/13/2006 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037-3213			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
DATE MAILED: 01/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,540	KINJO, NAOTO	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 16-19, 24-30 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20-23 and 31-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/26/05.

Newly submitted claim 45 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- Claim 45 is directed to switching an image on a display according to statistical tendencies of a photographed person, rather than according to characteristics of a user's image (face, height, etc) as previously elected.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 45 is hereby withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 3 appears to claim that the customer classification is based upon the second characteristic, yet claim 1 states that classification is based upon a

first characteristic. This appears to provide a conflict regarding the basis for the classification. If applicant intends classification to be based on both the first and second characteristics, then claim 3 should be amended to reflect such. As it stands, claim 3 appears to conflict with claim 1, rendering the claim scope unclear.

- Claim 42, there is no antecedent basis for the image display apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 32-36, 38, 41, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes) and Montero (US6133912).

Regarding claims 1, 2, 6, 11, 34, Eckhoff teaches bank machines which provide customized advertising as well as facial recognition technology. It is unclear whether the customization is based upon the identified user. Fridman teaches specifics of a customized ad banking system whereby user characteristics are identified biometrically, compared to stored images of the customer base and whereby customized ads are presented to the user based on this information. It would have been obvious to one of

ordinary skill at the time of the invention to have provided a centralized storage of previously-captured Eckhoff's user faces so that the advertising can be targeted to the identified user in order to provide more personalized and relevant ads. Targeting ads to the identified user as suggested inherently includes taking a photograph, extracting the face, analyzing a first characteristic (the features/shape of the face) and presenting targeted ads that match parameters of the user, however Fridman does not explicitly state how a targeted ad is selected, although he teaches that "through the use of iris recognition, the bank could then access any data base...and deliver targeted advertisements...to the customer." Montero however teaches delivering targeted ads to identified users. Montero teaches that an advertiser defines a desired target population segment such as males under 40 years of age with incomes exceeding \$50k [5:13-25] and that the identified user profile is relied upon to determine if the user is within that segment (i.e. a member of that classification) in which case the user will receive a particular targeted ad. It would have been obvious to one of ordinary skill at the time of the invention to have defined a targeted classification such as males under 40 and delivered the appropriate ad for such a classification when it is decided that the user is a member of that classification population, in order to provide targeted ads as desired by Fridman, The presentation of different ads for different people, targeted for one person vs. another person is taken to provide "switching" the ad content/image in accordance with the first characteristic. The screen that shows the ads is taken to be an image display apparatus. The plurality of ATM/bank machines which provide this advertising are taken to inherently be on the bank's communication network. However it would

have been obvious to one of ordinary skill at the time of the invention to have used any network for communication including the Internet as is well known.

Regarding claims 3, 4, Fridman's targeting of customized ads to users is taken to inherently include estimation of a characteristic such as "this person would likely be receptive to this selected ad." However Montero's suggestion for deciding whether a user is a member of a defined targeted audience provides the customer classification. The user's biometric first characteristic is used to determine gender, age, etc in order to determine the user's classification and determine the appropriate targeted ad. Applicant's use of the term "estimating" is taken to be met by accessing the identified user's data in the database which is relied upon to deliver the targeted ad. Any of the segment parameters (age, gender, income) are taken to meet the estimation of the second characteristic to determine customer classification.

Regarding claim 5, the ad selected for display to the particular user is taken to be a higher priority ad than other, non-displayed ads that were not chosen for display.

Regarding claims 7, 8, 41, the ATM machine could be considered an (arcade) game apparatus where the game played by the user is "what the heck is my PIN number again?". There are no features claimed which differentiate an ATM networked computer with a computer "game apparatus".

Regarding claims 9, 10, 32, 33, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of well known display such as a television monitor with the system of Eckhoff. The displayed advertisement is inherently in a specified area of the screen. A biometrically identified user at such a TV-

equipped advertising apparatus is taken to be “watching television” and the TV display is certainly a display capable of displaying a television program.

Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have stored the user profiles at a central server so that the plurality of ATMs can access the centralized required databases and deliver advertising across the network.

Regarding claims 13-15, Fridman teaches that the targeted ads can be displayed on a screen or by hard copy (mail). It would have been obvious to one of ordinary skill at the time of the invention to have provided a hard copy of the ads to the user at the ATM by way of the well known receipt printer. As stated above, the presentation of different ads, targeted for one person vs. another person is taken to provide “switching” the ad content/image, regardless of the medium of the output.

Regarding claims 35, 36, the equipment employed is taken to meet the broad “personal computer” which does not provide any particular structural or method step limitations.

Regarding claim 38, the display of Eckhoff is taken to meet the broad “electronic information board” (as well as “electronic poster”).

Regarding claim 44, the base claim (claim 20) now essentially provides the switching step as an optional one. The switching step is no longer required when there is no decision that display of the image would be prohibited. Nonetheless when ad 2 (targeted to that user’s classification) is displayed it is taken by the examiner to be determined as preferable to ad 1 (targeted to other user classifications). It can be said

that the system has decided that ad 1 is prohibited from display based upon classification. This is the case with the suggested combination.

Claims 31, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes), Montero and further in view of Kanevsky et al (US6421453). Kanevsky et al teaches a biometric system for limiting access to a computer system. Kanevsky et al teaches that many biometric characteristics can be used in order to identify the user including voice print, face recognition, body geometry (e.g. height, weight, hair color, hand geometry), etc [19:8-18, 11:65-66]. It would have been obvious to one of ordinary skill at the time of the invention to have included analysis of a user's height for example in order to more accurately identify the user.

Claims 20-23, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes).

Regarding claims 20, 21, 23, Eckhoff teaches bank machines which provide customized advertising as well as facial recognition technology. It is unclear whether the customization is based upon the identified user. Fridman teaches specifics of a customized ad banking system whereby user characteristics are identified biometrically,

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compared to stored images of the customer base and whereby customized ads are presented to the user based on this information. It would have been obvious to one of ordinary skill at the time of the invention to have provided a centralized storage of previously-captured Eckhoff's user faces so that the advertising can be targeted to the identified user in order to provide more personalized and relevant ads. Targeting ads to the identified user as suggested inherently includes taking a photograph, extracting the face, analyzing a first characteristic (the features/shape of the face) and presenting targeted ads based upon that first characteristic. The presentation of different ads, targeted for one person vs. another person is taken to provide "switching" the ad content/image in accordance with the first characteristic. The screen that shows the ads is taken to be an image display medium. Regarding claim 20, the claim now essentially provides the switching step as an optional one. The switching step is no longer required when there is no decision that display of the image would be prohibited. Nonetheless when ad 2 is selected as the targeted ad over ad 1, then it can be said that the system has decided that ad 1 is prohibited from display. This is the case with the suggested combination.

Regarding claim 22, the targeted ad selected for display to the particular user is taken to be a higher priority ad than other, non-displayed ads that were not chosen for targeted display.

Regarding claim 42, the biometric-outfitted apparatus of the proposed combination inherently includes a computer with software in order to acquire the image of the user and perform image analysis in order to identify the user.

Regarding claim 43, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of well known display such as a television monitor with the system of Eckhoff. The displayed advertisement is inherently in a specified area of the screen. A biometrically identified user at such a TV-equipped advertising apparatus is taken to be "watching television" and the TV display is certainly a display capable of displaying a television program.

Claims 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes) and further in view of Marsh et al (US6876974).

Marsh et al teaches selection of targeted ads to be displayed to an identified user. The selected ads are added to a display queue and are shown in a particular order, each for a predetermined period of time [3:15-25, 9:8-11]. It would have been obvious to one of ordinary skill at the time of the invention to have selected plural ads for the identified users of Eckhoff and shown them in a particular order so that more advertising can be sold (as well as seen by the users). The order of the targeted ad queue is taken to define the priority of the ads.

Response To Arguments

Applicant argues that Eckhoff and Fridman fail to teach targeting the image according to classification of the user. While Eckhoff uses biometrics and provides

targeted ads, applicant has argued that the targeting of Eckhoff's ads may not be based upon the biometrics. As such, Examiner has provided Fridman for biometrically based targeted ads. Fridman states "through the use of iris recognition, the bank could then access any data base...and deliver targeted advertisements...to the customer."

Applicant again argues that Fridman's targeted ads may be based merely on time or location, yet Fridman is taken to provide a positive teaching for biometrically-based targeting of ads. Subsequently the examiner feels it would have been obvious to one of ordinary skill at the time of the invention to have provided biometrically-based ads with the facial-recognition and advertising system of Eckhoff.

Applicant argues that the rejection does not teach classification of a user. Examiner has provided Montero as a teaching for an obvious method of how to accomplish the biometrically-based ad targeting desired by Fridman. Montero teaches defining targeted user segments (i.e. < 40 yr male) which is taken to provide the claimed classification-based targeting.

Applicant argues that Eckhoff and Fridman use biometrics for security and they would not use them to target multiple people. Examiner disagrees and relies on the teaching by Fridman that biometrics be used to provide targeted ads. Montero provides motivation to target segments of the population which include plural people (< 40 yr males).

Examiner repeats his assertion that the ATM of the applied art can read on a game machine.

Applicant argues that the applied art does not teach ad prohibited from display. Examiner repeats this previous assertions. First, the claim language is essentially optional and need not be provided by the prior art. Second, choosing a targeted ad for a particular person is taken to provide prohibiting the display of ads that were not chosen as appropriate for the identified user/classification/segment. The prior art need not state such an interpretation – it is inherent in the combination. Applicant argues that the ad priority is based upon the person – examiner's interpretation also takes this into account; the ads not chosen for a user are prohibited from display so that the targeted ad that is chosen can be displayed.

Examiner believes that the requisite hardware and software necessarily present in order to accomplish the biometric analysis and identification meets the claim language argued.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc